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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,715	02/17/2006	Fiona Murphy Kessabi	70305	7073

26748 7590 04/30/2009  
SYNGENTA CROP PROTECTION, INC.  
PATENT AND TRADEMARK DEPARTMENT  
410 SWING ROAD  
GREENSBORO, NC 27409

EXAMINER
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HENRY, MICHAEL C

ART UNIT	PAPER NUMBER
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1623

NOTIFICATION DATE	DELIVERY MODE
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04/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

department-gso.patent@syngenta.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,715	<b>Applicant(s)</b> KESSABI ET AL.	
	<b>Examiner</b> MICHAEL C. HENRY	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/17/06 &amp; 03/17/09</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The following office action is a responsive to the Amendment filed, 04/14/09.

Applicant's election with traverse of Group I in the reply filed on 04/14/09 is acknowledged. The traversal is on the ground(s) that there is no lack of a special technical feature for the group of inventions claimed. This is not found persuasive because there is a lack of a special technical feature for the group of inventions claimed by applicant. This is further supported or corroborated by the rejection set forth below.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3, 4, 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/14/09.

The amendment filed 04/14/09 affects the application 10/568,715 as follows:

1. Claims 1-2, the invention of Group I are prosecuted by the examiner.

Claims are 3, 4, 7 and 8 are withdrawn.

2. The responsive is contained herein below.

Claims 1-4, 7 and 8 are pending in application

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the phrase “if appropriate”. However, this phrase renders the claims indefinite. More specifically, it is unclear what is appropriate or when it is appropriate or not appropriate. Similarly, the claim recites the phrase “in free form”. However, it is unclear what constitutes a free form.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morozik (EP 375393 A1).

Claim 1 is drawn to a compound of a given formula ....., or, if appropriate, an E/Z isomer, E/Z isomer mixture and/or tautomer thereof, in each case in free form or in salt form.

Claim 2 is drawn to a pesticide composition which contains at least one compound of the formula (1) as active agent and at least one auxiliary.

Morozik teaches a subgenus that is fully embraced by the instant claim. Morozik discloses a subgenus of applicant's claimed compound wherein m is 0 or 1, R<sub>2</sub> is OR<sub>5</sub> and X is O, and R<sub>5</sub> is loweralkyl and R<sub>1</sub> is alpha branched C<sub>3-8</sub> alkyl (see claims, especially claim 1; see also abstract). It should be noted that the terminal group of applicant's compound of formula (1)

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wherein  $R_2$  is  $OR_5$  and X is O and  $R_5$  is  $C_{3-8}$ alkyl (including the bridging O) corresponds to the loweralkoxycarbonyloxy represented as  $R_5$  in Morozik's subgenus (see claims, especially claim 1; see also abstract). In addition, Morozik discloses that such compound can be used in a composition or medicament to treat parasitic infections (which includes plant parasitic infections or infectious diseases) (see claims, especially claim 1; see also abstract). Furthermore, Morozik discloses that a carrier can be used in said composition (see claims, especially claim 1; see also abstract).

Morozik does not recite a specific compound, but suggests a compound that read on the claimed invention (see claims, especially claim 1; see also abstract).

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to have prepared any of the compounds suggested by the subgenus of Morozik in order to use them to treat parasitic infections.

One having ordinary skill in the art would have been motivated, to prepare any of the compounds of a subgenus with a reasonable expectation that the compounds would have the utility of the subgenus as a whole. Therefore one skilled in the art would have been motivated to make specific compounds of the subgenus of Good et al. in order to treat parasitic infections.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 571-272-0652. The examiner can normally be reached on 8.30am-5pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be

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reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Henry  
April 22, 2009.

/Shaojia Anna Jiang/  
Supervisory Patent Examiner  
Art Unit 1623